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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,827	05/25/2001	Douglas Simpson	ClaimsPlace	7658
45722	7590	07/31/2008	EXAMINER	
Howard IP Law Group P.O. Box 226 Fort Washington, PA 19034			KOPPIKAR, VIVEK D	
			ART UNIT	PAPER NUMBER
			3626	
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			07/31/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/865,827	<b>Applicant(s)</b> SIMPSON ET AL.	
	<b>Examiner</b> VIVEK D. KOPPIKAR	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3,5-10,14-25,27,29-32 and 35-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3, 5-10, 14-25, 27, 29-32, and 35-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of the Application***

1. Claims 3, 5-10, 14-25, 27, 29-32 and 35-44 have been examined in this application. This communication is a non-final Office Action in response to the Request for Continued Examination (RCE) filed by the applicants on February 25, 2008.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 5-10 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi in view of "Cutting Out the Middleman" (hereinafter referred to as Middleman) and in further view of "Customers of Foremost Insurance Group Companies Can Now File Claims on the Company's Web Site" (hereinafter referred to as Foremost)).

(A) As per claims 3, Borghesi teaches a computer system for enabling claimants to self-service insurance claims for sustained, the system comprising:

a site generating component for generating a site on a global computer network for inputting insurance information from a plurality of sources (Borghesi: Col. 5, Ln. 51-Col. 6, Ln. 14);

a claim data analyzing component for analyzing the inputted information and identifying claimants verifying insurance coverage and summarizing the claims based on the analyzing; (Borghesi: Col.9, Ln. 43-56 and Col. 17, Ln. 61-63);

Borghesi does not teach the following features which are taught by Foremost: 1) enabling claimants to self-service insurance claims (Foremost: Full Text Section: Paragraphs 2-4); 2) allowing claimants to directly input the insurance claims for sustained losses (Foremost: Full Text Section: Paragraph 2-4); and 3) a claim rehabilitation component aggregating services related to loss recovery and automatically providing the aggregated services to the claimants to rehabilitate the sustained losses in accordance with said analyzing (Foremost: Full Text Section: Paragraphs 3 and 4)); and 4) wherein, the site generating component, claim data analyzing component and claim rehabilitation component enable claimants to self-service the claims for the sustained losses using the aggregated services (Foremost: Full Text Section: Paragraphs 3 and 4).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Borghesi with the aforementioned teachings from Foremost with the motivation of providing an added convenience to insured (customers), as recited in Foremost (Full text: Paragraph 2).

(B) As per claim 5, in Borghesi in view of Foremost the site is operative as an online claim reporting hub that permits the claimants to report details of personal and commercial insurance claims against any of a plurality of insurers (Borghesi: Figures 2-3 and Col. 5, Ln. 51-Col. 6, Ln. 5).

(D) As per claim 6, in Borghesi in view of Foremost the claimants include individuals and institutions (Borghesi: Figures 2-3 and Col. 5, Ln. 51-Col. 6, Ln. 5).

(E) As per claim 7, in Borghesi in view of Foremost the input insurance claims are selected from the group consisting of automobile claims, homeowners claims and business claims (Borghesi: Col. 2, Ln. 32-37).

(F) As per claim 8, in Borghesi in view of Foremost the site generating component accepts inputs from the global computer network and respond to site users graphically, in sound and in printable forms (Borghesi: Col. 12, Ln. 59-61).

(G) As per claim 9, in Borghesi in view of Foremost the system provides substantially continuous network claim service handling (Borghesi: Col. 5, Ln. 51-Col. 6, Ln. 5).

(H) As per claim 10, in Borghesi in view of Foremost the computer system further comprising a privacy preserving component for preserving site users' privacy while online at the site (Borghesi: Col. 15, Ln. 24-33).

(I) As per claim 14, in Borghesi in view of Foremost the computer system according to claim 3, wherein the system is adapted to process claims processing without an agent, broker or an insurance company (Borghesi: Figure 3 and Col. 5, Ln. 51-Col. 6, Ln. 5).

(J) As per claim 15, in Borghesi in view of Foremost the site is operative as an online consumer-to-business exchange that permits vendors of goods and services to advertise and offer products that individuals and businesses require to rehabilitate a loss (Borghesi: Col. 5, Ln. 5-50).

(K) As per claim 25, this claim is substantially similar to claim 3 insofar as claim limitations are concerned and is therefore rejected in the same manner as claim 3. (The only difference between claim 3 and claim 25 is that claim 3 is directed towards a system while claim 25 is directed towards a method).

(P) As per claim 27, in Borghesi in view of Foremost the site is operative as an online claim reporting hub that permits insurance claims to be put against any of a plurality of insurers at

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substantially any time (Borghesi: Figures 2-3 and Col. 5, Ln. 51-Col. 6, Ln. 5).

(R) As per claim 29, in Borghesi in view of Foremost the insurance claims are selected from the group consisting of automobile claims, homeowners claims and business claims (Borghesi: Col. 2, Ln. 32-37).

(S) As per claim 30, in Borghesi in view of Foremost the site generating step includes accepting inputs from the global computer network and responding to site users graphically, in sound and in printable forms (Borghesi: Col. 12, Ln. 59-61).

(T) As per claim 31, in Borghesi in view of Foremost the site generating step includes providing substantially continuous network claim service handling (Borghesi: Col. 5, Ln. 51-Col. 6, Ln. 5).

(U) As per claim 32, Borghesi in view of Foremost teaches further the step of preserving site users' privacy while online at the site (Borghesi: Col. 15, Ln. 24-33).

(X) As per claim 35, in Borghesi in view of Foremost the site is operative as an online consumer-to-business exchange that permits vendors of goods and services to advertise and offer products that individuals and businesses require to rehabilitate a loss (Borghesi: Col. 5, Ln. 5-50).

(Y) As per claim 36, in Borghesi in view of Foremost the aggregating step includes suggesting multiple vendors and services for performing tasks and requirements associated with rehabilitating a claim (Borghesi: Col. 5, Ln. 5-50).

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi in view of Foremost, as applied to Claim 3, above, and in even further view of Progressive.com (published on March 1, 2000).

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(A) As per claim 16, Borghesi does not teach multiple vendors and services for performing tasks and requirements associated with rehabilitating a claim, however, this feature is well known in the art as evidenced by Progressive.com (Page 1). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the system of Borghesi in view of Foremost with the aforementioned feature from Progressive.com with the motivation of providing a user with a means of comparing insurance policies before making a purchase, as recited in Progressive.com (Page 1).

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi in view of “Foremost”, as applied to Claim 3, above, and in even further view of US Patent Number 5,704,045 to King.

(A) As per claim 17, Borghesi does not teach that the site is operative as an online business-to-business exchange where sellers, market makers and investors transact for wholesale claims, post-accident purchase and sale of tranches of risk obligations, and subrogation rights, however, this feature is well-known in the art as evidenced by King (Col. 14, Ln. 42-58). At the time of the invention, one of ordinary skill it would have been obvious for one of ordinary skill in the art to have modified the system of Borghesi in view of Foremost with the aforementioned feature from King with the motivation of providing a means for investors to provide funds to support risk, as recited in King (Col. 14, Ln. 42-45).

8. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi in view of Foremost view of King as applied to Claim 17 above and in further view of US Patent Number 5,655,085 to Ryan.

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(A) As per claims 18-19, Borghesi in view of Foremost in view of King does not teach an automatic claim scoring and valuing component for automatically scoring a claim to determine the likelihood of recovery and valuing a claim. Borghesi in view of Foremost in view of King also does not teach the feature whereby the automatic claim scoring and valuing component values a claim's subrogation value by reviewing criteria including accident description, loss state, and responsible party and then assigns a subrogation value to the claim; however, the aforementioned features are well known in the art as evidenced by Ryan (Col. 1, Ln. 38-51). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined system of Borghesi in view of Foremost in view of King with the aforementioned teachings from Ryan with the motivation of providing a means for the subrogation rights purchasers to automatically determine which product provides the best value, as recited in Ryan (Col. 1, Ln. 45-49).

9. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi in view of Foremost in view of King in view of Ryan, as applied to Claim 19, above, and in even further view of US Patent Number 5,307,262 to Ertel.

(A) As per claims 20-21, the combined system of Borghesi in view of King and Ryan do not teach a claim bundling component that bundles the scored and claimed values into a group of claims that have commonality to the claim. The combined system of Borghesi in view of King and Ryan also does not teach a sale price determining component for determining a sale price for the bundled group of claims, however, the aforementioned features are well known in the art as evidenced by Ertel (Col. 5, Ln. 20-39 and Col. 29, Ln. 11-48). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined



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system of Borghesi in view of Foremost in view of King in view of Ryan with the aforementioned feature from Ertel with the motivation of facilitating the generation of a wide variety of useful summary reports, as recited in Ertel (Col. 29, Ln. 25-28).

10. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi in view of Foremost as applied to Claim 3 above and in further view of US Patent Number 6,453,297 to Burks.

(A) Borghesi does not teach a database which permits selected users to search for similar Claims (identify data patterns), thereby enabling the selected users to identify potential claims which are likely to develop as class action suits or mass tort claims. Borghesi also does not teach an identity concealment component (generic data format) for concealing the identities of claimants of the claims when searching for similar claims in the database, however, the aforementioned features are well known in the art as evidenced by Burks ( Col. 16, Ln. 34-46). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the system of Borghesi in view of Foremost with the aforementioned feature from Burks with the motivation of providing a user with a means of containing insurance costs, as recited in Burks (Col. 16, Ln. 42-45).

11. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system of Borghesi in view of “Foremost” in view of Burks, as applied to Claim 23, above, and in further view of Ertel.

(A) The combined system of Borghesi in view of Foremost in view of Burks also does not teach a sale price determining component for determining a sale price for the bundled group of claims, however, the aforementioned features are well known in the art as evidenced by Ertel

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(Col. 5, Ln. 20-39 and Col. 29, Ln. 11-48). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined system of Borghesi in view of Foremost in view of Burks with the aforementioned feature from Ertel with the motivation of facilitating the generation of a wide variety of useful summary reports, as recited in Ertel (Col. 29, Ln. 25-28).

12. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi in view of Foremost, as applied to Claim 25, and in even further view of King.

(A) As per claim 37, Borghesi in view of Foremost does not teach that the site is operative as an online business-to-business exchange where sellers, market makers and investors transact for wholesale claims, post-accident purchase and sale of tranches of risk obligations, and subrogation rights, however, this feature is well-known in the art as evidenced by King (Col. 14, Ln. 42-58). At the time of the invention, one of ordinary skill it would have been obvious for one of ordinary skill in the art to have modified the method of Borghesi in view of Foremost with the aforementioned feature from King with the motivation of providing a means for investors to provide funds to support risk, as recited in King (Col. 14, Ln. 42-45).

13. Claims 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi in view of Foremost in view of King, as applied to Claim 37, above, and in further view of US Patent Number 5,655,085 to Ryan.

(A) As per claims 38-39, Borghesi in view of King does not teach an automatic claim scoring and valuing component for automatically scoring a claim to determine the likelihood of recovery and valuing a claim. Borghesi in view of Foremost in view of King also does not teach the feature whereby the automatic claim scoring and valuing component values a claim's

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subrogation value by reviewing criteria including accident description, loss state, and responsible party and then assigns a subrogation value to the claim; however, the aforementioned features are well known in the art as evidenced by Ryan (Col. 1, Ln. 38-51). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined method of Borghesi in view of Foremost in view of King with the aforementioned teachings from Ryan with the motivation of providing a means for the subrogation rights purchasers to automatically determine which product provides the best value, as recited in Ryan (Col. 1, Ln. 45-49).

14. Claims 40-44 are rejected are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi in view of Foremost in view of King in view of Ryan, as applied to Claim 39, above and in further view of US Patent Number 5,307,262 to Ertel.

(A) As per claims 40-44, the combined method of Borghesi in view of Foremost in view of King in view of Ryan do not teach a claim bundling component that bundles the scored and claimed values into a group of claims that have commonality to the claim. The combined method of Borghesi in view of King in view of Ryan does not teach a sale price determining component for determining a sale price for the bundled group of claims. The combined method of Borghesi in view of Foremost in view of King in view of Ryan does not teach a step of providing a database and permitting selected users to search for similar claims, thereby enabling the selected users to identify potential claims which are likely to develop as class action suits or mass tort claims. The combined method of Borghesi in view of King in view of Ryan also does not teach the step of concealing the identities of the claimants of the claims during the claim searching step nor the step of pooling common issues into anonymous class action groups,

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however, the aforementioned features are well known in the art as evidenced by Ertel (Col. 5, Ln. 20-39 and Col. 29, Ln. 11-48). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined method of Borghesi in view of Foremost in view of King in view of Ryan with the aforementioned feature from Ertel with the motivation of facilitating the generation of a wide variety of useful summary reports, as recited in Ertel (Col. 29, Ln. 25-28).

### ***Response to Arguments***

15. (1) Applicant's argument with respect to the 35 U.S.C. 112 rejection have overcome the 35 U.S.C. 112 rejection set forth in the Office action dated September 25, 2007.

(2) Applicant's other arguments filed on February 22, 2008 with respect to the pending claims have been fully considered but they are not persuasive. Applicants' arguments will be addressed in sequential order as they were presented in the "Remarks" section filed on February 22, 2008.

(3) Applicants argue that the cited prior art references fail to teach or render obvious "A Site Allowing Claimants To Directly Input Information For Insurance Claims For Sustained Losses", however, this argument is now moot in view of the newly added 35 U.S.C. 103(a) rejection over the newly added Foremost reference.

(4) Applicants argue that the Office Action fails to explain how one would combine the Middleman reference with the teachings of Borghesi in view of Peterson to reach the claimed invention. This argument is now moot in view of the new grounds of rejection which includes the newly added Foremost reference. In addition, the Office

would like to note that none of the current 35 U.S.C. 103(a) rejections above do not rely on the Middleman reference.

(5) Applicant's argue that the Peterson reference and the Automating reference does not teach "automatically providing the aggregated services to claimants to rehabilitate the sustained losses in accordance with said analyzing." However, this argument is now moot in view of the new grounds of rejection which includes the newly added Foremost reference. In addition, the Office would like to note that none of the current 35 U.S.C. 103(a) rejections above do not rely on the Peterson reference or on the Automating reference.

(6) Applicant's argue that the Personal Progressive reference is not prior art. This argument is now moot in view of the new grounds of rejection which includes the newly added Foremost reference. In addition, the Office would like to note that none of the current 35 U.S.C. 103(a) rejections above do not rely on the Personal Progressive reference.

(7) Applicants argue that the cited prior art fails to teach or render obvious "analyzing the inputted insurance claim information and identifying the claimants, verifying insurance coverage and summarizing the claims based on the analyzing." However, the Office has clarified the 35 U.S.C. 103(a) rejection to more clearly show that Borghesi does in fact teach this feature at column 9, lines 43-56 and column 17, lines 61-63.

(8) Applicants argue that the cited prior art, when properly considered as a whole, fails to teach or suggest the recited invention of any of the pending claims.

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However, this argument is now moot in view of the newly added 35 U.S.C. 103(a) rejection which includes the newly added Foremost reference.

***Conclusion***

16. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,

/Vivek D Koppikar/

Examiner, Art Unit 3626

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